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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,901	09/22/2003	Charles S. Taylor	025925-000200US	2502

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,901

Applicant(s)

TAYLOR ET AL.

Examiner

Brian E. Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 33-74 and 85-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 75-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/13/04, 10/7/04, 6/22/06, 7/11/06, 8/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 33-74,85-97 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/4/06.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said arm" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3738

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,10,11,15,21,22,24-26,29-32,75,76,79-82 are rejected under 35

U.S.C. 102(e) as being anticipated by Quinn (6645242). Fig. 15 shows a stent-graft having an inner wall **280** surrounding a primary fluid conduit **235** extending through inlet **230** of anchor **210** and outlet **240** of second end **220** of anchor. It can also be seen there is an outer wall **200** and a forms an outboard with a void between the inner and outer wall with an interconnection between the void **290**. Fig. 7 shows the walls forming the inner primary channel **235** and lateral fluid channel **260**. Additionally the inner wall defines an arm such that a lateral fluid conduit **302** can be extended therein. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The void is fully capable of being filled with fixation media. Quinn discloses that the stent or anchors have the means to couple with the stent-graft, col. 8, lines 20-27. Quinn also discloses the interconnection is formed of "substantially inelastic" material, col. 7, lines 34-50 since these are rigid materials.

Claims 1-4,6-8,10,11,15,22-26,75,76,79-83 are rejected under 35 U.S.C. 102(e) as being anticipated by McDermott et al. (6312462). Fig. 2 shows a double walled anchor having an inner wall **34** surrounding a primary fluid conduit **14** and an outer wall **36** forming a void **32** between the inner and outer walls. McDermott et al. disclose that a

fixation media is included in the void, such as a liquid or gel that hardens to a solid, col. 4, lines 28-56. Fig. 1 illustrates the has a contour that defines lateral fluid conduits 16,18. McDermott also discloses the double wall anchor can be collapsed onto a catheter, col. 6, lines 15-20. Fig. 4 shows the device has interconnections 35 between the inner and outer walls.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Lane et al. (5494029). McDermott et al. is explained supra. However, McDermott fails to disclose a fixation media in the form of a gas or foam. Lane et al. teach the use of a gas or air to fill an anchoring body and also the use of a foam that permits expansion and allows the air to fill it, col. 2, lines 61-67 and col. 4, lines 27-44. It would have been obvious to one of ordinary skill in the art to substitute air and foam as a fixation media to expand an anchoring structure as taught by Lane et al. in the device of McDermott et al. such that it provides a controlled expansion and is easier to utilize or control since the foam is not free flowing.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Goldstein et al. (5976178). McDermott et al. is

explained supra. However, McDermott et al. fail to teach the use of a parylene portion with the device. Goldsteen et al. teach that parylene coatings as liners form a smooth lubricious layer, col. 19, lines 41-44,47,52-54. It would have been obvious to one of ordinary skill in the art to utilize a parylene coating as a liner as taught by Goldsteen et al. and incorporate it with the device of McDermott et al. such that it improves the surface characteristics for improved blood flow.

Claims 18-21,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462 in view of Cox (5824040). McDermott et al. is explained supra. However, McDermott fails to disclose an expandable stent surrounding the arm and defining the lateral conduit to join the lateral lumen with the primary lumen. Cox teaches (Figs. 3A,3B) a branched prosthesis with a graft **68** connected with a primary fluid conduit **64**. Cox also teaches that stents and liners can be used with the graft, col. 11, lines 59,60. It would have been obvious to one of ordinary skill in the art to incorporate a stent with the graft device of McDermott as it is well known that stent expandable members support the grafts in the vessels and prevent collapse and movement.

Claims 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. '462. McDermott et al. is explained above. However, McDermott fails to disclose the shape of the separate chambers as toroids. It would have been an obvious matter of design choice to modify the shape of chambers, since applicant has not disclosed that using toroid shaped voids provide any advantage, or solve a stated problem, or are used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the

shape of the void chambers taught by McDermott or the claimed toroid shape in claim(s) 84 because both anchor devices perform the same function of providing a replacement vessel permitting fluid flow.

Claims 16,17,27,28,77,78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn '242. Quinn is explained supra. Quinn also discloses that the interconnection between walls can be done (col. 9, lines 43- col. 10, line 12) in a variety of ways or functional equivalents, but fails to disclose quilting walls or regions. It would have been an obvious matter of design choice to modify the interconnection between walls, since applicant has not disclosed that using quilting walls or regions provide any advantage, or solve a stated problem, or are used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the interconnection or partition taught by Quinn or the claimed quilting interconnection in claim(s) 16,17,27,28,77,78 because both interconnection perform the same function of providing a rigid stable wall portion for the stent-graft.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M-Th (8:30am-6pm) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BRIAN E PELLEGRINO
PRIMARY EXAMINER

